

REMARKS

The Office Action of September 9, 2008 has been received and carefully reviewed. It is submitted that, by this Amendment and Response and previous Amendments and Responses submitted, all bases of rejection are traversed and overcome. Claims 1-5, 8-15 and 18-26 remain in the application. Reconsideration of the claims is respectfully requested.

Status of claims: Claims 6 and 9 stand rejected under 35 U.S.C. § 112, second paragraph; claims 11-16, 18-20 and 26 stand rejected under 35 U.S.C. § 112, first paragraph; and claims 1-6, 8-16 and 18-26 are subject to election/restriction.

35 U.S.C. § 112 Rejections

Claims 6 and 9 stand rejected under 35 U.S.C. § 112, second paragraph because, according to the Examiner, the claims contain a limitation that conflicts with the parent claim, namely that the telematics unit is active.

While the Applicants do not acquiesce to the Examiner's rejections, in order to expedite prosecution, claim 6 has been cancelled herein. Claim 9 has been amended to remove the recitation that the telematics unit is active. Claims 16, 19 and 23 also contain similar recitations. As such, claim 16 has been cancelled herein and claims 19 and 23 have been amended in a manner similar to claim 9. As such, the rejection of claims 6 and 9 under 35 U.S.C. § 112, second paragraph is rendered moot.

Claims 11-16, 18-20 and 26 stand rejected under 35 U.S.C. § 112, first paragraph because these claims recite a physical medium including computer readable codes, and according to the Examiner, support for these computer readable codes is not found in the pending disclosure. Particularly regarding claim 26, the Examiner states that it is unclear and vague as to how the computer readable code has a structural relationship to the other physical components.

Applicants strongly disagree with the Examiner's conclusions that "computer readable code" is not enabled by the specification as filed. It is submitted that the specification as filed, at least from page 13, line 15 through page 20, line 29 provides support for "computer readable code". For example, page 14 provides examples of suitable servers and databases, and page 15 states that the voice portal and portal application are, respectively, suitable voice-based and web-based software frameworks. As another example, page 18, at lines 27-29, states that "the program stored in the computer usable medium comprises computer program code for executing the method steps described in FIGS. 4-6." One of the method steps discussed in reference to Figs. 3 and 4 is determining the download status (see page 19, line 25 through page 20, line 29). More particularly, page 20, at lines 1-14, states that, "voice portal 333...provides interaction between a customer as well as vehicle client 320 and an application operating within application server 330 via a wireless carrier system to determine the download status of VCS application 390 and hence the download status of the telematics unit...." In light of this support, and the amendments to the claims in the previously filed responses, Applicants submit that the 35 U.S.C. § 112, first paragraph rejection of claims 11-16, 18-20 and 26 is erroneously based, and withdrawal of the same is respectfully requested.

Specifically regarding claim 26, Applicants have amended this claim to recite, "a voice portal configured to provide interaction between the mobile vehicle and an application operating within an application server at the call center to determine a download status of the telematics unit and associated components, wherein the download status is a fixed status requiring the mobile vehicle to maintain a stationary period for a predetermined fixed time period...." Support for this revision may be found throughout the specification as filed, at least at page 13, lines 6-14, page 15, lines 5-21, and page 20, lines 1-14. In light of this support and the amendment to claim 26, Applicants submit that the 35 U.S.C. § 112, first paragraph rejection of claim 26 is rendered moot, and withdrawal of the same is respectfully requested.

Election/Restriction

In the Election/Restriction section of the Office Action of September 9, 2008, the Examiner restricted the claims of the application under 35 U.S.C. § 121 to one of the following two species:

- I. Claims 1, 2, 4, 11, 21, 25 and 26 which require a stationary period of the mobile vehicle; and
- II. Claims 3, 5, 8-10, 12-15, 18-20, and 22-24 which do not necessarily require a stationary period of the mobile vehicle.

Also in the Election/Restriction section of the Office Action of September 9, 2008, the Examiner quotes MPEP § 806.04(c) (which Applicants assume is supposed to be MPEP § 806.05(c)II) and concludes that a restriction between combination and sub-combination is required. The Examiner states that the Applicants must elect a single species from each of the following groups:

- I. Claim 1 or Claim 5;
- II. Claim 1 or Claim 3; and
- III. Claim 21 or Claims 22-24

In response to the first of these Restriction Requirements, Applicants provisionally elect, with traverse, Species II (Claims 3, 5, 8-10, 12-15, 18-20, and 22-24). In response to the second of these Restriction Requirements, Applicants provisionally elect, with traverse, in

Group I - claim 5, in Group II - claim 3, and in Group III - claims 22-24. Applicants traverse these Restriction Requirements for at least the following reasons.

MPEP § 803 states that:

If the search and examination of all the claims in an application can be made without serious burden, the examiner ***must*** examine them on the merits, even though they include claims to independent or distinct inventions. (Emphasis added).

Furthermore, MPEP § 806.05(c) states that:

To support a requirement for restriction between combination and subcombination inventions, ***both two-way distinctness and reasons for insisting on restriction are necessary***, i.e., there would be a serious search burden if restriction were not required as evidenced by separate classification, status, or field of search. (Emphasis added).

The Applicants submit that examination of all of the pending claims together would not impose a serious burden on the Examiner. The Examiner has **not** provided any showing of two-way distinctness; and further, he has provided **no** evidence and **no** analysis to show that examining these inventions/species would be a serious burden. In fact, the Examiner has not set forth ***any*** separate classifications, statuses, or fields of search for the two species of the first restriction or for the claims within the various groups of the second restriction.

In fact, Applicants submit that there is **no** serious burden on the Examiner to search and examine all of the pending claims. Claims 3, 5, 8-10, 12-15, 18-20, and 22-24 had ***already been searched, examined and identified as being allowed or containing allowable subject matter*** (see Office Action dated July 6, 2007). The previous Examiner never issued a restriction requirement, but issued a first substantive non-final Office Action on January 17, 2007 (in which claims 3, 5, 8-10, 13, 15 and 18-20 were noted as containing allowable subject matter), to which Applicants responded on April 17, 2007, and a second substantive final Office Action on July 6, 2007 (in which claims 3-6, 13 and 15 were allowed, and claims 8-10,

18-20, 22 and 24 were noted as containing allowable subject matter), to which Applicants responded on September 6, 2007.

The current Examiner then took over prosecution of the instant application, and without citing any references, he withdrew the indication that such claims contained allowable subject matter because “there is no incredible step...” (see Office Action of February 1, 2008). Applicants fail to see why further prosecution of these claims would constitute a serious burden on the Examiner. As such, it is submitted that the Examiner has **not** made a *prima facie* showing of a serious burden to further examine the **already-examined** pending claims without the instant restrictions.

Further, Applicants assume for purposes of this response that the Examiner has made a complete requirement for restriction in accordance with MPEP §§ 815 and 817. If the Examiner has not made a complete requirement, then Applicants respectfully request that the Examiner withdraw this restriction requirement and provide a complete restriction requirement so that Applicants can properly assess the Examiner's assertions.

Lack of U.S.C. §§ 102 and 103 Rejections

In the Office Action dated September 9, 2008, the Examiner again states that “generic/broadest claim 3 is not allowable because it obviously contains ideas about well-known steps of: receiving a signal at location B...in response, sending signals from location B to location A for settings...and sending an extra signal (e.g., an update signal) from location B to location A.” First, it is submitted that the Examiner has misinterpreted Applicants’ claim 3, which recites that the sending of the update flag signal (the extra signal according to the Examiner) occurs **prior to** the call center receiving the vehicle settings update signal. Applicants’ update flag signal is sent **before** the vehicle settings update signal, and thus is not an “extra signal” as set forth by the Examiner.

Second, in making the conclusion that the Examiner-misinterpreted version of Applicants’ claim 3 is obvious, the Examiner DOES NOT CITE any references under either

§§ 102 or 103. Applicants fail to see how such conclusory statements can be made without supplying ANY evidence in support of such conclusions, especially given that some deference should be given to the previous patent Examiner, who had searched and reviewed the prior art, had examined all the pending claims, and had indicated that claim 3 (among others) was allowable.

As such, it is submitted that at least this portion of the instant Action is improper, and Applicants have no way of evaluating and responding to the same. Both the MPEP and 37 C.F.R. speak to the Examiner's duty to render a clearly understandable Office Action:

MPEP § 706 Rejection of Claims [R-5]

After the application has been read and the claimed invention understood, a prior art search for the claimed invention is made. With the results of the prior art search, including any references provided by the applicant, the patent application should be reviewed and analyzed in conjunction with the state of the prior art to determine whether the claims define a useful, novel, nonobvious, and enabled invention that has been clearly described in the specification. **The goal of examination is to *clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.*** (emphasis added)

37 CFR 1.104. Nature of examination.

(c) Rejection of claims.

(1) If the invention is not considered patentable, or not considered patentable as claimed, the claims, or those considered unpatentable will be rejected.

(2) **In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command.** When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. (emphasis added)

As stated above, the Examiner has **not** clearly articulated any rejections for the unpatentability of the pending claims (other than the previously addressed 35 U.S.C. § 112 rejections), contrary to the requirement under MPEP § 706; nor has he cited the best references at his command (he did not cite any), contrary to the requirement under 37 C.F.R. § 1.104. Applicants request that if the Examiner is going to continue to allege that the claims are not patentable, that he set forth a clearly articulated rejection and the best references at his command, such that the Applicants can respond appropriately.

In summary, claims 1-5, 8-15 and 18-26 remain in the application. It is submitted that, through this Amendment and Response, Applicants' invention as set forth in these claims is now in a condition suitable for allowance.

Further and favorable consideration is requested. If the Examiner believes it would expedite prosecution of the above-identified application, he is invited to contact Applicants' Attorney at the below-listed telephone number.

Respectfully submitted,

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